

## **REMARKS**

### **Specification**

This application is related to other filed applications. The specification has been amended to include the serial numbers for the cross references on page 1, paragraph 1. These amendments do not add any new matter to the specification.

### **Information Disclosure Statement**

It has been noted that the references submitted by Applicants on June 29, 2000, in the above-entitled case were not considered by the Examiner. It is also noted that the substitute 1449 Form which accompanied the Office Action is stamped "RECEIVED JUL 6 - 2000 GROUP 2700." Pursuant to a telephone call to the Examiner with regard to these references, his response was that these references were not found in the file wrapper. Applicants assume that they were separated from the Patent Office's file wrapper and, therefore, resubmit the references for the Examiner's consideration.

### **Claim Rejections -- 35 U.S.C. § 103(a)**

In section 2 of the present Office Action, Claims 1-72 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Katz* (US Patent No. 6,055,513, issued April 25, 2000, filing date 03/11/1998) hereinafter referred to as ("*Katz*"). This rejection is respectfully traversed and reconsideration of the claims is requested.

Exemplary Claim 1 in the present application recites the step of:

*filtering output of said designated offerings of services and products at an output interface associated with said portable data processing system according to user output filtering preferences, such that said particular user receives a filtered selection of said electronically provided services and products via an output interface associated with said portable data processing system.*

On page 4 of the present Office Action, the Examiner admits that *Katz* does not explicitly teach the above step of Claim 1, yet sets forth the position that *Katz* suggests the same without reciting a single passage of *Katz* that would support the Examiner's burden of showing a *prima facie* case of obviousness. ("The Examiner should set forth in the Office Action the relevant

teachings of the prior art relied upon, preferably with reference to the relevant column or page numbers and line numbers where appropriate.” MPEP 706.02(j)) The Office Action goes on to state that the suggestion or motivation to modify *Katz* in order to render the present invention obvious is based on “Official Notice” that the concepts and advantages of the elements of Claims 2-11 are well known and expected in the art at the time of the invention. Applicants specifically dispute the suggestion to combine the steps as recited in Claim 1 is “in the knowledge generally available to one of ordinary skill in the art.” The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants’ disclosure. (See *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991)). The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)). Applicants respectfully submit that the Examiner has used improper hindsight in light of the present application to find the present invention obvious.

First, Applicants submit that the step of “*filtering output of said designated offerings of services and products associated with said portable data processing system according to user output filtering preferences*” is not something that is generally known to those skilled in the art. If it is generally known to use a laptop to filter services and products that are offered according to user output filtering preferences, then the Examiner should have no difficulty in finding many references with such a teaching. Applicants respectfully request a citation to such a reference or withdrawal of the rejection of Claim 1 as being unpatentable under Section 103.

Second, the Examiner has set forth no reasoning of why there is some suggestion or motivation in the teaching of *Katz* to add such a filtering capability on the consumer’s computer. *Katz* teaches that one or more users 160 interface with *Katz*’s disclosed system via computer 162 (see column 19, line 59-column 20, line 22). Yet *Katz* nowhere teaches the addition of a filtering function on such computer 162 despite the clear advantage “for effecting remote commerce ...

which are particularly adapted for the intelligent selection and proffer of products, services, or information to a user or customer” (see page 5 of the present Office Action reciting *Katz* at column 8, lines 34-40). Consequently, Applicants respectfully submit that the rejection of Claim 1 as being unpatentable over *Katz* is improper because there is no suggestion in the prior art to make the suggested combination. With respect to Claims 3-7, 11-12, 14-18, 22-23, 25-29, and 33, Applicants submit for the reasons given above with respect to exemplary Claim 1 that these claims are similarly not shown or suggested by *Katz* and that the rejection of these claims under Section 103 should be withdrawn.

With regard to exemplary Claim 8, therein is recited the step of:

*analyzing said designated offerings of services and products received from each of said plurality of independent server systems at said portable data processing system.*

On page 4 of the present Office Action, the Examiner admits that *Katz* does not explicitly teach the above step of Claim 8, yet sets forth the position that *Katz* suggests the same without reciting a single passage of *Katz* that would support the Examiner’s burden of showing a *prima facie* case of obviousness. (“The Examiner should set forth in the Office Action the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page numbers and line numbers where appropriate.” MPEP 706.02(j)) The Office Action goes on to state that the suggestion or motivation to modify *Katz* in order to render the present invention obvious is based on “Official Notice” that the concepts and advantages of the elements of Claims 2-11 are well known and expected in the art at the time of the invention. Applicants specifically dispute the suggestion to combine the steps as recited in Claim 8 is “in the knowledge generally available to one of ordinary skill in the art.” The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants’ disclosure. (See *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991)). The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of

the references.” *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)). Applicants respectfully submit that the Examiner has used improper hindsight in light of the present application to find the present invention obvious.

First, Applicants submit that the step of “*analyzing said designated offerings of services and products received from each of said plurality of independent server systems at said portable data processing system*” is not something that is generally known to those skilled in the art. If it is generally known to use a laptop to analyze services and products that are offered, then the Examiner should have no difficulty in finding many references with such a teaching. Applicants respectfully request a citation to such a reference or withdrawal of the rejection of Claim 8 as being unpatentable under Section 103.

Second, the Examiner has set forth no reasoning of why there is some suggestion or motivation in the teaching of *Katz* to add such an analysis capability on the consumer’s computer. *Katz* teaches that one or more users 160 interface with *Katz*’s disclosed system via computer 162 (see column 19, line 59-column 20, line 22). Yet *Katz* nowhere teaches the addition of an analysis function on such computer 162 despite the clear advantage “for effecting remote commerce ... which are particularly adapted for the intelligent selection and proffer of products, services, or information to a user or customer” (see page 5 of the present Office Action reciting *Katz* at column 8, lines 34-40). Consequently, Applicants respectfully submit that the rejection of Claim 1 as being unpatentable over *Katz* is improper because there is no suggestion in the prior art to make the suggested combination. With respect to Claims 9-10, 19-21, 30-32, Applicants submit for the reasons given above with respect to exemplary Claim 1 that these claims are similarly not shown or suggested by *Katz* and that the rejection of these claims under Section 103 should be withdrawn.

With respect to Claim 34, it has been included to recite the steps of:

*determining a selection of electronic advertising associated with said designated products and services from among a plurality of electronic advertisements accessible at said particular server system;*  
*controlling output of said selection of electronic advertising from said particular server system to a plurality of diverse output interfaces; and*

*adjusting a selection of output interfaces which receive a particular electronic advertisement according to the detected location of said portable data processing system associated with said particular user.*

On page 7 of the present Office Action, the Examiner admits that *Katz* does not explicitly teach the above steps of Claim 34, yet sets forth the position that *Katz* suggests the same without reciting a single passage of *Katz* that would support the Examiner's burden of showing a *prima facie* case of obviousness. ("The Examiner should set forth in the Office Action the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page numbers and line numbers where appropriate." MPEP 706.02(j)) The Office Action goes on to state that the suggestion or motivation to modify *Katz* in order to render the present invention obvious is based on "Official Notice" that the concepts and advantages of the elements of Claims 35-38 are well known and expected in the art at the time of the invention. Applicants specifically dispute the suggestion to combine the steps as recited in Claim 34 is "in the knowledge generally available to one of ordinary skill in the art." The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. (See *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991)). The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. ("To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)). Applicants respectfully submit that the Examiner has used improper hindsight in light of the present application to find the present invention obvious.

First, Applicants submit that the steps of

*determining a selection of electronic advertising associated with said designated products and services from among a plurality of electronic advertisements accessible at said particular server system;*  
*controlling output of said selection of electronic advertising from said particular server system to a plurality of diverse output interfaces; and*

*adjusting a selection of output interfaces which receive a particular electronic advertisement according to the detected location of said portable data processing system associated with said particular user.*

are not something that is generally known to those skilled in the art. If it is generally known, then the Examiner should have no difficulty in finding many references with such a teaching. Applicants respectfully request a citation to such a reference or withdrawal of the rejection of Claim 34 as being unpatentable under Section 103.

Second, the Examiner has set forth no reasoning of why there is some suggestion or motivation in the teaching of *Katz* to add such a capability to the system. *Katz* nowhere teaches the addition of such function to his system despite the clear advantage “for effecting remote commerce ... which are particularly adapted for the intelligent selection and proffer of products, services, or information to a user or customer” (see page 7 of the present Office Action reciting *Katz* at column 8, lines 34-40). Consequently, Applicants respectfully submit that the rejection of Claim 34 as being unpatentable over *Katz* is improper because there is no suggestion in the prior art to make the suggested combination. With respect to Claims 35, 38-40, 43-44, Applicants submit for the reasons given above with respect to exemplary Claim 34 that these claims are similarly not shown or suggested by *Katz* and that the rejection of these claims under Section 103 should be withdrawn.

With respect to Claim 45, therein is recited the steps of:

*transmitting a registration indicator for said particular user from said particular server system to said portable computer system in said particular transmittable data format, such that said particular user is automatically registered with said plurality of consumer providers by transmitting said single user profile to said plurality of server systems; and*  
*transmitting a registration cookie from said particular server system to said particular portable computer system.*

On page 9 of the present Office Action, the Examiner admits that *Katz* does not explicitly teach the above steps of Claim 45, yet sets forth the position that *Katz* suggests the same without reciting a single passage of *Katz* that would support the Examiner’s burden of showing a *prima facie* case of obviousness. (“The Examiner should set forth in the Office Action the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page

numbers and line numbers where appropriate.” MPEP 706.02(j)) The Office Action goes on to state that the suggestion or motivation to modify *Katz* in order to render the present invention obvious is based on “Official Notice” that the concepts and advantages of the elements of Claims 46-50 are well known and expected in the art at the time of the invention. Applicants specifically dispute the suggestion to combine the steps as recited in Claim 45 is “in the knowledge generally available to one of ordinary skill in the art.” The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants’ disclosure. (See *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991)). The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)). Applicants respectfully submit that the Examiner has used improper hindsight in light of the present application to find the present invention obvious.

First, Applicants submit that the steps of:

*transmitting a registration indicator for said particular user from said particular server system to said portable computer system in said particular transmittable data format, such that said particular user is automatically registered with said plurality of consumer providers by transmitting said single user profile to said plurality of server systems; and*  
*transmitting a registration cookie from said particular server system to said particular portable computer system.*

is not something that is generally known to those skilled in the art. If it is generally known, then the Examiner should have no difficulty in finding many references with such a teaching. Applicants respectfully request a citation to such a reference or withdrawal of the rejection of Claim 45 as being unpatentable under Section 103.

Second, the Examiner has set forth no reasoning of why there is some suggestion or motivation in the teaching of *Katz* to add such a transmission capability to the system. *Katz*

teaches that one or more users 160 interface with *Katz*'s disclosed system via computer 162 (see column 19, line 59-column 20, line 22). Yet *Katz* nowhere teaches the addition of the above-cited transmission function despite the clear advantage "for effecting remote commerce ... which are particularly adapted for the intelligent selection and proffer of products, services, or information to a user or customer" (see page 10 of the present Office Action reciting *Katz* at column 8, lines 34-40). Consequently, Applicants respectfully submit that the rejection of Claim 45 as being unpatentable over *Katz* is improper because there is no suggestion in the prior art to make the suggested combination. With respect to Claims 46-49, 51-55, and 57-59, Applicants submit for the reasons given above with respect to exemplary Claim 45 that these claims are similarly not shown or suggested by *Katz* and that the rejection of these claims under Section 103 should be withdrawn.

With respect to Claim 61, therein is recited the step of:

*controlling output of selective instructions for staff of said particular consumer provider, in response to filtering said plurality of consumer preferences according to products or services provided by said particular consumer provider, such that said staff for said particular consumer provider receive selective instructions for serving said particular user according to said plurality of consumer preferences and said products or services provided by said particular consumer provider when said particular user is within a particular proximity of said particular consumer provider.*

On page 12 of the present Office Action, the Examiner admits that *Katz* does not explicitly teach the above step of Claim 61, yet sets forth the position that *Katz* suggests the same without reciting a single passage of *Katz* that would support the Examiner's burden of showing a *prima facie* case of obviousness. ("The Examiner should set forth in the Office Action the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page numbers and line numbers where appropriate." MPEP 706.02(j)) The Office Action goes on to state that the suggestion or motivation to modify *Katz* in order to render the present invention obvious is based on "Official Notice" that the concepts and advantages of the elements of Claims 62-64 are well known and expected in the art at the time of the invention. Applicants specifically dispute the suggestion to combine the steps as recited in Claim 61 is taught by *Katz* or is "in the knowledge generally available to one of ordinary skill in the art." The teaching or



suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. (See *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991)). The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. ("To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)). Applicants respectfully submit that the Examiner has used improper hindsight in light of the present application to find the present invention obvious.

First, Applicants submit that the step of "*controlling output of selective instructions for staff of said particular consumer provider, in response to filtering said plurality of consumer preferences according to products or services provided by said particular consumer provider, such that said staff for said particular consumer provider receive selective instructions for serving said particular user according to said plurality of consumer preferences and said products or services provided by said particular consumer provider when said particular user is within a particular proximity of said particular consumer provider*" is not something that is generally known to those skilled in the art. If it is generally known, then the Examiner should have no difficulty in finding many references with such a teaching. Applicants respectfully request a citation to such a reference or withdrawal of the rejection of Claim 61 as being unpatentable under Section 103.

Second, the Examiner has set forth no reasoning of why there is some suggestion or motivation in the teaching of *Katz* to add such a capability to the system. *Katz* nowhere teaches the addition of controlling instructions despite the clear advantage "for effecting remote commerce ... which are particularly adapted for the intelligent selection and proffer of products, services, or information to a user or customer" (see page 12 of the present Office Action reciting *Katz* at column 8, lines 34-40). Consequently, Applicants respectfully submit that the rejection of Claim 61 as being unpatentable over *Katz* is improper because there is no suggestion in the prior art to make the suggested combination. With respect to Claims 62-69, Applicants submit

for the reasons given above with respect to exemplary Claim 61 that these claims are similarly not shown or suggested by *Katz* and that the rejection of these claims under Section 103 should be withdrawn.

With respect to Claim 70, therein is recited the step of:

*controlling output of said filtered electronic advertisements from among said plurality of electronic advertisements to a particular output device from among said plurality of output devices wherein said particular user is detected within a particular proximity of said particular output device, such that said electronic advertisements for said particular retailer are adjusted at said plurality of output devices according to consumer preferences of users within a particular proximity of each of said plurality of output devices.*

On page 14 of the present Office Action, the Examiner admits that *Katz* does not explicitly teach the above step of Claim 1, yet sets forth the position that *Katz* suggests the same without reciting a single passage of *Katz* that would support the Examiner's burden of showing a *prima facie* case of obviousness. ("The Examiner should set forth in the Office Action the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page numbers and line numbers where appropriate." MPEP 706.02(j)) Applicants specifically dispute the suggestion to combine the steps as recited in Claim 70 is provided at column 8, lines 34-40 of *Katz*. The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. (See *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991)). The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. ("To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)). Applicants respectfully submit that the Examiner has used improper hindsight in light of the present application to find the present invention obvious.

First, Applicants submit that the step of "*controlling output of said filtered electronic*

*advertisements from among said plurality of electronic advertisements to a particular output device from among said plurality of output devices wherein said particular user is detected within a particular proximity of said particular output device, such that said electronic advertisements for said particular retailer are adjusted at said plurality of output devices according to consumer preferences of users within a particular proximity of each of said plurality of output devices*” is not suggested. *Katz* has no mention of “filtered electronic advertisements,” or detecting a user “within a proximity” of devices or outputs at such devices in accordance with “consumer preferences.”

Second, the Examiner has set forth no reasoning of why there is some suggestion or motivation in the teaching of *Katz* to add such advertisement capability to the system. *Katz* nowhere teaches the addition of filtered advertising despite the clear advantage “for effecting remote commerce ... which are particularly adapted for the intelligent selection and proffer of products, services, or information to a user or customer” (see page 14 of the present Office Action reciting *Katz* at column 8, lines 34-40). Consequently, Applicants respectfully submit that the rejection of Claim 70 as being unpatentable over *Katz* is improper because there is no suggestion in the prior art to make the suggested combination. With respect to Claims 71-72, Applicants submit for the reasons given above with respect to exemplary Claim 70 that these claims are similarly not shown or suggested by *Katz* and that the rejection of these claims under Section 103 should be withdrawn.

No fee is believed to be required by this amendment; however, in the event any additional fees are required, please charge those fees to **IBM Corporation Deposit Account Number 09-0447**.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Craig Yudell", is written over a horizontal line.

Craig Yudell

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